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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,714	04/09/2004	Mitsuyoshi Okuda	251697US0	9489

22850 7590 12/09/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

CLARK II, WILLIAM PAUL

ART UNIT	PAPER NUMBER
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1656

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/820,714	Applicant(s) OKUDA ET AL.	
	Examiner William P. Clark	Art Unit 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/01/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Election / Restriction

Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I Claims 1-2, drawn to a mutant alkaline protease, classified in class 435, subclass 221.

Group II Claims 3-10, drawn to gene, vector and transformant, classified in class 536, subclass 23.2.

Group III Claims 11-12, drawn to detergent composition comprising the alkaline protease, classified in class 510, subclass 114.

2. The inventions are distinct, each from the other because:

The DNA of Group II is related to the protease of Group I by virtue of the fact that the DNA encodes the protease. The DNA molecule has utility for the recombinant production of the protein in a host cell. Although the DNA and the protein are related, they are distinct inventions because they are wholly different in structure and function. A DNA's structure is comprised of linear, contiguous nucleotides while a protein's structure comprised of linear, contiguous amino acids that fold into a specific three-dimensional structure; the DNA's function is to encode a protein while a protein's function is variable, and in this case, a protease. Therefore, Groups I is distinct from Group II.

While Group I and Group II can be identically classified under U.S. Patent Classification guidelines, to search them together would present a search burden on the Examiner due to the extensive databases of non-patent literature. For example, claims in Group I, drawn to a protease polypeptide, must be searched not only in commercial amino acid sequence databases, but also in

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textual databases because isolated proteases are often disclosed without the benefit of sequence information although the amino acid sequence is inherently the same as the sequence claimed. Additionally, the nucleic acid sequences must be searched in distinct nucleic acid sequence commercial databases. Thus, Group I and Group II have been appropriately restricted on the basis of being both independent or distinct and presenting a search burden on the Examiner if they were to be searched together. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Group I and Group III are related in that they share an alkaline protease, but the groups differ in function. Group I is a protease product that can be used to purify DNA from contaminating proteins such as histones. Group III is a detergent composition containing a protease used for the cleaning of soiled clothing. Thus, Group I is distinct from Group III. The search of the classification of group I does not encompass the search of the classification of group III, therefore, they would be burdensome to be searched together. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Group II and Group III are related in that they share an alkaline protease, but the groups differ in structure and function. Group II is drawn to a gene, vector, and host cell. These may be used in the production of the protease. Group III is a detergent composition containing the protease. A detergent composition contains beside the protease also surfactants, chelating agents, and other agents to help in the cleaning of solid surfaces. The search of genes, vectors,

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and host cells does not encompass that of detergent compositions, therefore they would be burdensome to be searched together. Because these inventions are distinct for the reasons given above, and burdensome to be searched together, restriction for examination purposes as indicated is proper.

Election

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). With the election of an invention from Groups I-III, Applicant is further required to elect **one** particular combination of the substituted amino acids for the positions : (a), (b), (c), (d), (e), (f), (g) for the alkaline protease sequence of SEQ ID NO:1 for examination. (For instance: (a) position will be histidine, (b) will be threonine, and so on, so that **a single** sequence of a particular combination of substitutions is chosen for examination.) One particular combination of mutations (substitutions) in the alkaline protease would not render another combination of mutations(substitutions) obvious. **The election of a specific combination is a species election.**

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Clark whose telephone number is 571-272-8138. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/06/05 WC

W.C.

AR
**HOPE ROBINSON
PATENT EXAMINER**